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In re Application of ARIMA et al. :  
Application No.: 09/403,603 :  
PCT No.: PCT/JP98/01844 :  
Int. Filing Date: 22 April 1998 : DECISION ON PETITION  
Priority Date: 23 April 1997 :  
Attorney Docket No.: 19051.072 : UNDER 37 CFR 1.137(a)  
For: ELECTRODE AND BATTERY :

This is a decision on applicants' "Renewed Petition to Revive/Request for Reconsideration", filed in the United States Patent and Trademark Office (USPTO) on 08 November 2002.

### **BACKGROUND**

The procedural history of this application is set forth in previous decisions and hereby incorporated by reference. Suffice it to say that the application was abandoned as applicants did not file a timely response to the 29 June 2000 Notification of Defective Response (Form PCT/DO/EO/916) and Notification of Defective Oath or Declaration (Form PCT/DO/EO/917).

On 26 July 2001, a Notification of Abandonment was mailed to applicants.

On 29 July 2002, applicants filed a petition to revive the abandoned application under 37 CFR 1.137(a) and a petition under 37 CFR 1.47(a) to accept the application without the signature of applicant/inventor Hisashi Tsukamoto.

On 31 October 2002, a decision was mailed to applicants indicating that the petition under 37 CFR 1.47(a) was granted but the petition to revive under 37 CFR 1.137(a) was dismissed without prejudice. Applicants were advised that their explanation of unavoidable delay was insufficient to prove that the application was unavoidably abandoned.

On 08 November 2002, applicants filed the instant reconsideration/renewed petition to revive the application under 37 CFR 1.137(a).

### **DISCUSSION**

In their renewed petition to revive under 37 CFR 1.137(a), applicants argue that "the submission of a copy of the executed declaration would not have resulted in revival of the application in the absence of the required evidence of the eighth inventor's refusal to execute the

declaration and therefore would have been a futile act.”

Applicants are reminded that the application was held abandoned because applicants had failed to file a proper response to the 29 June 2000 Notification of Defective Response and Notification of Defective Oath or Declaration. The Notification of Defective Response indicated that the declaration had “two sole or first inventors, Yoichiro Arima and Hisashi Tsukamoto”. The notice also stated that the names of the fifth and seventh inventors on the declaration did not correspond to the published international application.

The Notification of Defective Oath or Declaration (Form PCT/DO/EO/917) informed applicants that (1) “the application failed to contain an oath or declaration acceptable under 35 U.S.C. 371(c)(4) for entry into the national stage” and (2) “a new oath or declaration, identifying this application by the international application number and international filing date is required”. The Notice further advised applicants that the declaration as submitted was “not executed in accordance with 37 CFR 1.66 or 37 CFR 1.68”. Furthermore, applicants were advised that “FAILURE TO SUBMIT AN OATH OR DECLARATION IN COMPLIANCE WITH 37 CFR 1.497(a) AND (b) WITHIN THE TIME PERIOD SET WILL RESULT IN FAILURE TO ENTER THE NATIONAL STAGE AND THE ABANDONMENT OF THE APPLICATION.” (Emphasis in original). The 29 June 2000 Notifications set a one month deadline from the date of the Notification or by 29 July 2000.

Applicants originally alleged that they mailed an executed declaration on 17 July 2000 but this submission is not found in the application file. The paper, found in the application file bearing a date-stamp of 17 July 2000, is entitled “Response to Notification of a Defective Response and Response to Notification of Defective Oath or Declaration under 35 U.S.C. 371(c)(4)”. This paper notes a change of address of agent and informs the Office of a typographical error relating to two of the inventors Shioda and Arakane. However, this paper was not responsive as described above to either Notifications mailed on 29 June 2000.

Thus, the application became abandoned on 30 July 2000 for failure to properly reply to Notification of Defective Response and Notification of Defective Oath or Declaration mailed on 29 June 2000. The period of abandonment is from 30 July 2000 until the filing of a grantable petition under 37 CFR 1.137. The three periods to be considered during the evaluation of a petition under 37 CFR 1.137 are: (1) the delay in reply that originally resulted in the abandonment; (2) the delay in filing an initial petition pursuant to 37 CFR 1.137 to revive the application; and (3) the delay in filing a grantable petition pursuant to 37 CFR 1.137 to revive the application.

#### The Delay in Reply That Originally Resulted in the Abandonment

With regard to the delay in reply that originally resulted in the abandonment, as explained above, applicants’ submission on 17 July 2000 was not responsive to the Notifications issued on 29 June 2000, causing the application to be abandoned. Applicants were first notified of the requirement of an oath or declaration in compliance with 37 CFR 1.497 in this application with the Notification of Missing Requirements mailed on 03 December 1999. An acceptable declaration was not filed until 09 February 2001, almost 8 months after the Forms 916 and 917 were issued and 14 months after the Notification of Missing Requirements was mailed first notifying applicants of the deficiency. This delay in filing an acceptable declaration, as a responsive reply to the Forms 916 and 917, has not been explained by applicants nor have applicants explained how this delay in filing a responsive reply was “unavoidable”. As stated in MPEP §711.03(c) (p.700-149) unavoidable requires that degree of care that is “generally used and observed by prudent and careful men in relation to their most important business.” Applicants were amply warned of the problem with the declaration and have not detailed their use of such care to address the problem declaration. Rather, as evident by the 17 July 2000

response to the Forms 196 and 917, the delay in filing the proper reply appears to be attributed in part to applicants' mistaken belief that the 17 July 2000 communication was a proper reply to the outstanding notice. As stated in MPEP 711.03(c), delay caused by an applicant's lack of knowledge.... is not "unavoidable".

#### The Delay in Filing an Initial Petition Pursuant to 37 CFR 1.137 to Revive the Application

The next period to consider is the delay in filing an initial petition pursuant to 37 CFR 1.137 to revive the application. In this case, the initial petition pursuant to 37 CFR 1.137 was not filed until 29 July 2002. This amounts to a two year period between the time the application was abandoned and the filing of a petition to revive and a one year period between the time applicants were notified of the abandonment in the decision dated 19 July 2001 and the filing of the initial petition to revive on 29 July 2002.

With the instant petition, applicants rely on a telephone memorandum dated 01 August 2001 and allege that the note is a summary of a contact with the undersigned. Such contact is not noted in the record nor recalled by the undersigned. Pursuant to 37 CFR 1.2, such alleged oral communication may not be relied upon. It is acknowledged that there was no fixed period for response set in the 19 July 2001 decision as the case was abandoned. As such, by operation of statutes, applicants could not intentionally, and in the case of petition under 37 CFR 1.137(a), avoidably delay in filing the petition to revive.

Furthermore, as stated in the MPEP §711.03(c), a delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to the applicant's reliance upon oral advice from USPTO employees. Thus, applicants cannot rely on an alleged telephone discussion in pursuing revival under the unavoidable standard, which is in direct conflict with the MPEP instructions on this matter.

It is also well-established that an applicant who fails to file a petition under 37 CFR 1.137(a) "promptly" upon becoming notified, or otherwise becoming aware, of the abandonment of the application will not be able to show that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable. *Id.*

Applicants state that the "submission of a copy of the executed declaration would not have resulted in revival of the application in the absence of the required evidence of the eighth inventor's refusal to execute the declaration and therefore would have been a futile act." More than a year expired between the 19 July 2001 decision, notifying applicants of abandonment, and the filing of the 25 July 2002 petition to revive; this delay has not been shown to be "unavoidable". Thus, in summary, petitioners have failed show both that the delay in filing the required reply and the delay in filing the initial petition to revive were unavoidable.

For the above stated reasons, applicants' request for reconsideration of the petition to revive under 37 CFR 1.137(a) is dismissed.

#### Option

The dismissal or denial of a petition under 37 CFR 1.137(a) does not preclude an applicant from obtaining relief pursuant to 37 CFR 1.137(b) on the basis of unintentional delay (unless the decision dismissing or denying the petition under 37 CFR 1.137(a) indicates otherwise). In such an instance, a petition under 37 CFR 1.137(b) may be filed accompanied by the fee set forth in 37 CFR 1.17(m), the required reply, a statement that the entire delay in filing

the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, and any terminal disclaimer required by 37 CFR 1.137(c).

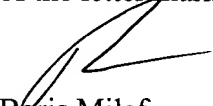
**CONCLUSION**

For the reasons above, the application is considered **ABANDONED**.

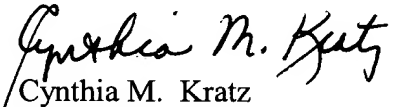
Any reconsideration must be filed within **TWO (2) MONTHS** of this decision and will be reviewed as a final Office action.

Any petition to revive the application under 37 CFR 1.137(b) must be filed within **TWO (2) MONTHS** from the mail date of this decision.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT Legal, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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